

Remarks

The numbered paragraphs of the Office action are responded to through the corresponding numbered paragraphs below. The applicant has addressed each issue in turn and, for clarity, has provided a heading for each issue.

1. The Examiner indicated an amendment was received from the applicant on November 8, 2002. The applicant believes that no response is required for this paragraph.

*Claim Rejections – 35 USC § 103*

2. The Examiner provided the citation to 35 U.S.C. § 103(a), which forms the basis for all obviousness rejections set forth in this Office action. The applicant believes that no specific response is required for this paragraph.

3. The Examiner rejected claims 1–10 "under 35 U.S.C. § 103(a) as being unpatentable over Carlisle (U.S. 5,664,975)." The applicant has requested that claims 1 and 7, on which claims 2–6 and 8–10 depend be amended to more clearly point out that applicant's invention includes a circular shaped insert panel which holds said first side of the cover into a circular shape. The Examiner admitted that Carlisle does not disclose the use of an insert panel to define the shape of the first side and stated that "[i]t is known in the art to utilize an insert panel within a cover or bag to define the shape for a side of said cover or bag." The applicant respectfully traverses this rejection. The statute expressly requires that obviousness be determined for the claims subject matter

"as a whole. See, In re Antonie, 559, F.2d 618, 195 USPQ 6 (CCPA) 1977). Claim limitations cannot be ignored and the Office cannot use the applicant's disclosure as a blueprint for reconstructing the claimed invention out of the prior art, In re Jansson, 609 F.2d 996, 203 USPQ 976 (CCPA 1979). Moreover, the applicant has included specific functional language ("which holds said first side of said cover into a circular shape") that must be found in the prior art to sustain a §103 rejection. See, In re Caldwell, 138 USPQ 243 (CCPA 1963). Since the Examiner does not provide a properly combinable reference showing all of the limitations of the claims of applicant's pending claims, it appears to the applicant that the Examiner is ignoring limitations in the claims and/or is essentially stating that it is "obvious to try" to insert a panel in the cover to define the shape. Neither of these approaches is permitted by the Federal Circuit. The applicant believes that claims 1 and 7 as amended, and claims 2-6 and 8-10 because they depend on claims 1 and 7, include elements neither described nor suggested by the cited reference, either alone or in combination with any other known reference. The applicant respectfully requests reconsideration and withdrawal of this rejection.

*Response to Arguments*


4. The Examiner stated that the applicant's arguments filed on November 8, 2002 have been fully considered but were not found to be persuasive. The applicant appreciates the Examiner's considerations and requests consideration of this response.

*Conclusion*

5. The Examiner indicated that this action is made final and that a shortened statutory period for reply is set. The applicant is responding to this final Office action with a Request for Continued Examination, Petition for Extension of Time and fees within the permitted extension period. The applicant believes that this response is fully responsive to this final action and respectfully requests continued examination.
6. The Examiner has provided information concerning communication and/or inquiries concerning this case. Applicant appreciates the Examiner's willingness to communicate and assistance regarding this case and believes no response to this paragraph is necessary.

The applicant has requested that claims 1 and 7 be amended as previously described. The applicant believes that all issues and points of the Examiner's Office action have been addressed. Applicant believes that the pending claims 1-10 including the amended claims 1 and 7, are patentable over all known prior art. Applicant respectfully requests reconsideration and allowance of this application.

Respectfully submitted this 27th day of May, 2003.



Lloyd W. Sadler, Reg. No. 40,154  
PARSONS BEHLE & LATIMER  
201 South Main Street, Suite 1800  
Salt Lake City, Utah 84111  
Telephone: (801) 532-1234  
Facsimile: (801) 536-6111